THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES J. SCHMIDT

Appeal No. 98-1183
Application No. 08/352,513[1]

ON BRIEF

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 13, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

[1] Application for patent filed December 9, 1994.

BACKGROUND

The appellant's invention relates to a method and apparatus for cleaning tilt-in, double hung windows. An understanding of the invention can be derived from a reading of exemplary claims 1 and 8, which are reproduced infra.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Reynolds	4,027,802	June 7, 1977
Prete et al. (Prete)	5,251,401	Oct. 12, 1993
Purves	642,299 (British)	Aug. 30, 1950

Claims 1 through 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Prete in view of Purves and Reynolds.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 12, mailed September 24, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellant's

brief (Paper No. 11, filed June 23, 1997) for the appellant's arguments thereagainst.

OPINION

Initially we note that the appellant on page 4 of the brief has grouped the claims as standing or falling together in the following manner: Group I, claims 1 through 7 and 9, and Group II, claims 8 and 10 through 13. However, the appellant has provided a separate argument on page 9 of the brief for the patentability of claim 13. Accordingly, we will not treat claim 13 as being within the second grouping of claims. Instead claim 13 will be treated separately. In accordance with 37 CFR § 1.192(c)(7), we have selected claim 1 as the representative claim from Group I and claim 8 as the representative claim from Group II. Thus, we will review claims 1, 8 and 13 to decide the appeal on the rejection under 35 U.S.C. § 103.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is

sufficient to establish obviousness with respect to claim 8 but not with respect to claims 1 and 13. Accordingly, we will sustain the examiner's rejection of claim 8, and claims 10 through 12 which fall with claim 8, under 35 U.S.C. § 103. We will not sustain the examiner's rejection of claims 1 through 7, 9 and 13 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual

to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Prete discloses a double-hung window assembly having tilt-in sashes.

Purves discloses a collapsible trestle. As shown in Figures 1-3, the trestle includes a vertical member (i.e., main body 7), a stand (i.e., bars 12, bars 14, rod 10^{b}), at

least one pivotable cross-member (i.e., arms 8) and padding (i.e., strips 8[e]).

Reynolds discloses a building board positioner. As shown in Figures 1 and 2, the positioner includes a vertical member having adjustment means disposed thereon for selectively adjusting the length thereof (i.e., sections 20, 24, 28 and 32 and vertical adjustment means 65), a stand (i.e., base 12), at least one cross-member (i.e., arms 38, 40, 42 and 44) and at least element extending from a top surface of one cross-member (i.e., stop member 46 to prevent lateral movement of a board or panel during use of the positioner).

Claim 1

Claim 1 recites:

> A method of positioning a sash of a tilt-in window in a position suitable for washing, comprising the steps of:
> providing a free standing support;
> positioning said free standing support proximate the tilt-in window;
> adjusting said free standing support to a desired height; and
> tilting a sash from said tilt-in window to a point where the sash rests upon and is supported by said free standing support.

The examiner determined (answer, p. 3) that "it would have been obvious to have provided a free standing support in lieu of using one's hand or the window sill in order to free both hands to clean the window [of Prete]." Thereafter, the examiner determined (answer, p. 4) that

> [t]o have used the trestle of the British patent [Purves] to prop open the window of Prete et al. when cleaning would have been obvious to one having ordinary skill in the art, since the trestle is a general support and it is generally recognized that windows would be propped when applying a downward cleaning force on them.

The appellant argues (brief, pp. 7, 8 and 10) that the method steps set forth in claim 1 are not suggested by the applied prior art. We agree. In that regard, the examiner has not cited any evidence that would have led an artisan to have tilted a sash from a tilt-in window to a point where the sash rests upon and is supported by a free standing support in the manner recited by claim 1. It is our view that the examiner's determination of obviousness is based on speculation, unfounded assumption and/or impermissible hindsight reconstruction to supply the deficiencies in the factual basis for the rejection.

For the reasons set forth above, the decision of the examiner to reject claim 1, and claims 2 through 7 and 9 dependent thereon, under 35 U.S.C. § 103 is reversed.

Claim 8

Claim 8 recites:

> A static support for supporting the sash of a tilt-in window, comprising:
> a vertical member having an adjustment means disposed thereon for selectively adjusting the length thereof;
> a stand coupled to said vertical member, wherein said stand holds said vertical member in a generally vertical orientation;
> at least one cross-member pivotably coupled to said vertical member, wherein said at least one cross member can be selectively pivoted into a position generally perpendicular to said vertical member;
> padding disposed on a top surface of said at least one cross member; and
> at least one element extending from said at least one cross member beyond said top surface that engages an edge of the sash thereby retaining the sash in a predetermined orientation relative to said static support.

After the scope and content of the prior art are determined, the differences between the prior art and the

claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Purves and claim 8, it is our opinion that the only differences are the limitations that (1) the vertical member has an adjustment means disposed thereon for selectively adjusting the length thereof, and (2) the at least one cross member has at least one element extending beyond its top surface.

With regard to these differences, the examiner determined (answer, p. 4) that

> [i]t would have been obvious at the time of the invention for one having an ordinary level of skill in the art to have provided the vertical support member of the British patent's [Purves] trestle with a height adjusting means and to also have provided the cross member [of Purves] with extending elements as taught by Reynolds in order to better support the article on the British patent's trestle and subsequently position it at a selected height.

We agree.

We find the appellant's argument (brief, pp. 8-10) with respect to claim 8 unpersuasive for the following reasons.

First, the appellant argues the deficiencies of each reference on an individual basis. However, nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

Next, the appellant argues that subject matter recited in claim 8 is not suggested by the applied prior art. We do not agree. As set forth above, we agree with the examiner that the teachings of Reynolds would have suggested modifying the trestle of Purves by (1) making the length of the vertical member adjustable, and (2) providing stop members on the cross members. The suggestion and motivation for such modifications come from the teachings of Reynolds, not impermissible hindsight. In that regard, Reynolds clearly teaches that (1) the length of his vertical member is adjustable to raise or lower the height of his cross members, and (2) stop members are provided on the cross members to prevent lateral movement of the board or panel supported by the cross members.

Lastly, the appellant argues that the applied prior art does not suggest that the at least one element (i.e., Reynolds' stop members 46) engage an edge of a sash thereby retaining the sash in a predetermined orientation relative to the static support. While this is true, it is our opinion that claim 8 does not recite the combination of the static support and sash. Instead, claim 8 is directed to the static support, per se, intended for use with the sash of a tilt-in window as recited in the preamble of claim 8. All that the functional recitations of the last clause of claim 8 require is at least one element extending from the at least one cross member beyond the top surface that is **capable of engaging** an edge of a sash and thereby retaining the sash in a predetermined orientation relative to the static support. It seems the appellant is endeavoring to predicate patentability upon the method of using the static support. However, the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. See In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); In re Yanush, 477 F.2d, 958, 959, 177 USPQ 705, 706 (CCPA 1973). Furthermore, it is our opinion that Purves'

trestle provided with the stop members in accordance with the teachings of Reynolds would be capable of engaging an edge of a sash thereby retaining the sash in a predetermined orientation relative to the trestle (i.e., the static support).

For the reasons set forth above, the decision of the examiner to reject claim 8, and claims 10 through 12 dependent thereon, under 35 U.S.C. § 103 is affirmed.

Claim 13

Claim 13 adds to parent claims 8 and 12[2] the limitation that the static support has "at least two elements that extend from said at least one cross member, wherein said at least two elements engage the two side edges of the peripheral frame at points generally opposite each another."

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[2] Claim 12 reads as follows: "The static support according to Claim 8, wherein the sash has a peripheral frame of a predetermined width that extends in between two side edges and said at least one element engages at least one of the two side edges of the peripheral frame, thereby preventing said free standing support from inadvertently moving independently from the peripheral frame."

The appellant argues (brief, p. 9) that

> none of the references cited by the Examiner disclose two elements, such as those claimed, that engage the two side edges of a sash's peripheral frame at points generally opposite to each other.

We agree.

The examiner did not respond to this argument in the answer. While Reynolds would have suggested providing multiple stop members on the cross members of Purves, there is no suggestion in the applied prior art to space two of the stop members apart so that they would have been capable of engaging two side edges of the peripheral frame of a sash at points generally opposite each another. Since all the limitations of claim 13 are not suggested by the applied prior art, the decision of the examiner to reject claim 13 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 13 under 35 U.S.C. § 103 is affirmed with

respect to claims 8 and 10 through 12 but is reversed with respect to claims 1 through 7, 9 and 13.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS Administrative Patent Judge	)
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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APPEAL NO. 98-1183 - JUDGE NASE
APPLICATION NO. 08/352,513

APJ NASE

APJ ABRAMS

APJ STAAB

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 1 Dec 98

FINAL TYPED: